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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,271	01/15/2002	Milton B. Yatvin	90,663-QQ	9913
20306	7590	04/21/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			NAFF, DAVID M	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			1651	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,271

Applicant(s)

YATVIN ET AL.

Examiner

David M. Naff

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/23/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment of 1/5/04 amended the abstract, canceled claim 17, and amended claims 11, 18, 19, 21 and 22.

Claims examined on the merits are 1-16 and 18-25 which are all
5 claim in the application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

Claims 1-16 and 18-25 are rejected under the judicially created
10 doctrine of obviousness-type double patenting as being unpatentable over claims 25-73 of U.S. Patent No. 6,339,060 B1 or claims 24-51 of U.S. Patent No. 6,063,759 or claims 1-25 of U.S. Patent No. 5,840,674 or claims 1-19 of U.S. Patent No. 5,543,391. Although the conflicting
claims are not identical, they are not patentably distinct from each
15 other because coating porous particles impregnated with a biologically active compound with an organic coating compound would have been obvious from the claims of the patents that require coating porous or nonporous particles containing a prodrug or an antimicrobial drug, with a coating material. It would have been obvious to use a
20 biologically active compound rather than a prodrug of the compound.

Response to Arguments

Applicants elect to defer submission of a Terminal Disclaimer until all other grounds of rejection have been withdrawn.

The claims are free of the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is
5 set to expire THREE MONTHS from the mailing date of this action. In
the event a first reply is filed within TWO MONTHS of the mailing date
of this final action and the advisory action is not mailed until after
the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action
10 is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be
calculated from the mailing date of the advisory action. In no event,
however, will the statutory period for reply expire later than SIX
MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier
15 communications from the examiner should be directed to David M. Naff
whose telephone number is 571-272-0920. The examiner can normally be
reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful,
the examiner's supervisor, Mike Wityshyn can be reached on 571-272-
20 0926. The fax phone number for the organization where this
application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David M. Naff
Primary Examiner
Art Unit 1651

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DMN

4/19/04